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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/122,293	07/24/1998	MASAHICO SAKAYORI	1232-4457	4239
27123	7590	08/25/2005		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 08/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/122,293

Applicant(s)

SAKAYORI ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,11,21 and 37-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,11,21 and 37-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This non-final Office action is responsive to Applicant's amendment filed May 27, 2005.

Claims 2, 9, 10, 12-20, and 22-36 have been cancelled.

Claims 38-49 have been added.

Claims 1, 3-8, 11, 21, and 37-49 are pending.

2. The previous indication of allowable subject matter is withdrawn in response to newly identified rejections, set forth below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-8, 11, 21, and 37-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While the preamble of claim 1 recites a "parts ordering system having a first domain, a second domain and a third domain connected in a tree structure," the preamble ultimately sets forth that the body of the claim is specifically directed toward the details of the second domain (i.e., "wherein said second domain includes"). However, the last two limitations of claim 1 further define the first domain and third domain as having the various recited means. Since the second domain does not

comprise the first and third domains, it is improper to claim structural details of these domains as features further limiting the scope of the second domain. Consequently, the structural limitations attributed to the first and third domains do not merit patentable weight. Similar issues arise in claims 7 and 8.

Furthermore, the next to last limitation recited in claim 1 also states that the second domain has many means that are already recited in the previous limitations of claim 1, thereby raising the question of whether or not the seemingly repetitive means are redundant in relation to the second domain or somehow different in scope because claim 1 utilizes inconsistent claim terminology. For example, both a "receiving means for receiving an order" and "means for receiving an order" are recited in relation to the second domain. What is the difference, if any, in scope between these two means? Similar issues arise with the uses of machine planning means versus means for devising a machining plan based upon the order received, expansion means for expanding versus means for performing expansion, and order planning means versus the combination of means for devising an ordering plan, means for ordering a part, means for reading data, and means for writing the read data to the database. This inconsistent use of terminology raises antecedent basis problems in dependent claims 3-8 and 11 as well.

Claim 1 recites that the "communication means prevents the first domain and the third domain from communicating the order to each other." It is not clear what the scope of prevention is. Are all communications necessarily routed through this communication means which terminates any attempt by the first and third domains to

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communicate order information to one another? Is only the transmission of order information (as opposed to other types of information) blocked? If so, how does the communication means recognize one type of communicated information from another? Which specific order information is blocked; both the first and second domains appear to generate a particular type of order information. Also, since the claim recites that the second domain includes the communication means, are all communications routed through the second domain? If so, how is it ensured that the first and third domains not communicate with one another except when routed through the second domain's communication means? Even if the second domain routes order information from the first domain to the third domain, the first domain is effectively allowed to communicate with the third domain, albeit through the third domain as an intermediary, thereby rendering the claim language vague and indefinite. Dependent claim 11 recites that stopping means are used for "stopping the communication of an order to the third domain in a case where the amount of specific parts contained in inventory is greater, by a prescribed amount, than the required amount of specific parts." Which order does this refer to -- the order from the first domain or the parts order presumably generated by the second domain?

The last limitation of claim 1 recites that "a plurality of connections are made possible on a network in a tree structure." Which connections are referred to in particular and how do they relate to the specific functionality recited throughout the claim?

Claims 3-8 and 11 are dependent from claim 1 and therefore inherit all rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

Claims 38-41 recite an apparatus with many of the limitations already recited in claim 1; therefore, rejections regarding common limitations recited in both sets of claims apply.

Claims 21, 37, and 42-49 recite method claims corresponding to much of the functionality already recited in claims 1, 3-8, and 11; therefore, rejections regarding common limitations recited in both sets of claims apply. Similar issues arise in relation to repetitively recited steps (e.g., a receiving step at which the second domain receives an order versus a step of receiving an order, a machine planning step at which the second domain devises a machining plan versus a step of devising a machining plan, an expansion step versus a step of performing expansion, and an order planning step versus the combined recitation of a step of devising an ordering plan, ordering a part, reading data, and writing the read data to the database). Again, the inconsistency in terminology is confusing and potentially redundant in relation to the second domain. Furthermore, there is little integration among the first, second, and third domains; therefore, the impact of each domain being able to perform the functionality recited in the clause "wherein said first domain, second domain and third domain each perform..." on the claimed invention as a whole is not clear. In other words, since the second domain performs much of the recited functionality, the fact that the first and second domains are capable of performing some of the same functionality is irrelevant since it is not clear how all of these capabilities are expressly used by each domain to

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communicate with one another. The second domain appears to actively perform this functionality, so it is not clear what the impact of each domain merely being capable of performing the same steps has on the integration of all three domains.

Appropriate correction and/or clarification is required.

*Due to the numerous and extensive rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).*

### **Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

August 22, 2005